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09/482,843	01/13/2000	Marcus Peinado	MSFT-0103/127334.6	7584

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EXAMINER

NGUYEN, CUONG H

ART UNIT

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3625

DATE MAILED: 02/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/482,843	Applicant(s) Marcus Peinado et al.
Examiner Cuong H. Nguyen	Art Unit 3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 3/07/2000 (the IDS)

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-135 is/are pending in the application.

4a) Of the above, claim(s) 1-105 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 106-135 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) Notice of References Cited (PTO-892)

18) Interview Summary (PTO-413) Paper No(s). _____

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) Notice of Informal Patent Application (PTO-152)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3

20) Other: _____

DETAILED ACTION

1. This Office Action is the answer to the communication received on 5/02/2000 (the CFR).
2. Claims 106-135 are pending in this application

Drawings

3. This application has been filed with formal drawings which currently are acceptable for examining purposes.

Claim Rejections - 35 USC §101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

4. Claims 106-120 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are merely directed to a software package (standing alone), and that package contains computer program per se (see "Examination Procedures for Computer-Related Inventions - 2/27/1996, box 6" a USPTO guideline); this package (by itself) do not produce a useful, tangible, concrete result (without being act on by something else, that "something else" must be claimed to make that "computer program per se" become meaningful) according to "State Street" case.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112 (claims 106, & 121):

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5.A. Re. To claim 106: It lacks an antecedent basis for "the package being separate and apart from the license" in line 3, page 2 (of claim 106) submitted on 1/13/2000; this claim is about a package; however, based on above limitation, the license stands on its own (not in the claimed package).

This claim is also unclear about a meaning of term(s): "a content/package ID" (on page 3, line 3). For clarification, the examiner submits to replace above phrase with - a content or a package ID --.

This phrase is unclear "identifying one of the digital content and the package". It would be contradict to "a content/package ID".

5.B. Re. To claims 121: This claim is unclear for:

A similar deficiency of claim 106 is repeated; that is claim 121 is about a medium with a data structure only. Then, from where "a license" comes from; should it be contained in that claimed medium or not in that medium; in the second case (if not in said medium) the examiner submits that "a digital license" can not be weighted as part of a limitation in claim. The above problem of "a content/package ID" should also be corrected to avoid indefinite problems.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 106-135 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **Stefik** (US Pat. 5,715,403), in view of **Krishnan**, (US Pat. 6,073,124).

A. Re. To claim 121: **Stefik** discloses a structure including:

- encrypted digital content (see **Stefik**, "The requester records the work contents, data, and usage rights. It then creates a one-time key and encrypts the contents file. It saves the key information in a restoration file.")

(See **Stefik**, Detailed Description Text (341):

In some cases, it is convenient to be able to archive the large, encrypted contents file to secure offline storage, such as a magneto-optical storage system or magnetic tape"), to be rendered in accordance with a corresponding digital license, the encrypted digital content being decryptable according to a decryption key (See **Stefik**, "Each repository has given the other a key to be used in decrypting further communications during the session. Since that key is itself transmitted in the public key of the receiving repository only it will be able to decrypt the key which is used to decrypt subsequent messages."), obtained from the license (See **Stefik**, "Since licenses

are themselves digital works, the same mechanisms give the creators control over distributors by charging for licenses and putting time limits on their validity.);

(See **Stefik**, Detailed Description Text (444) :

A creator purchases a digital distribution license that he will hand out to his distributors. He puts access requirements (such as a personal license) on the Copy and Transfer rights on the distribution license so that only he can copy or transfer it.);

(See **Stefik**, Detailed Description Text (484) :"

The creator creates a digital work, an upgrade ticket, and a distribution license.");

- a field containing a content/package ID identifying one of the digital content and the package (see **Stefik**, Fig.12 - ref. 1207) ;

- **Stefik** also discloses that: "FIG. 4b is an example of a computer system as a rendering system. A computer system may constitute a "multi-function" device since it may execute digital works (e.g. software programs) and display digital works (e.g. a digitized photograph).

Logically, each rendering device can be viewed as having its own repository, although only one physical repository is needed. Referring to FIG. 4b, a computer system 410 has contained therein a

display/execution repository 411. The display/execution repository 411 is coupled to display device, 412 and execution device 413. The dashed box surrounding the computer system 410 represents a security

boundary within which communications are assumed to be secure. The display/execution repository 411 is further coupled to a credit server 414 to report any fees to be billed for access to a digital work and a

repository 415 for accessing digital works stored therein." ; and "The hardware embodiment of a repository will be enclosed in a secure housing which if compromised, may cause the repository to be

disabled. The basic components of the hardware embodiment of a repository are described with reference to FIG. 12. Referring to FIG. 12, a repository is comprised of a processing means 1200, storage system 1207, clock 1205 and external interface 1206. The processing means 1200 is comprised of a processor element 1201 and processor memory 1202. The processing means 1201 provides controller, repository

transaction and usage rights transaction functions for the repository. Various functions in the operation of the repository such as decryption and/or decompression of digital works and transaction messages are also performed by the processing means 1200. The processor element 1201 may be a microprocessor or other suitable computing component. The processor memory 1202 would typically be further comprised of Read Only Memories (ROM) and Random Access Memories (RAM). Such memories would contain the software instructions utilized by the processor element 1201 in performing the functions of the repository.

— And "...The user interface itself need not be part of the repository. As a repository may be embedded in some other device, the user interface may merely be a part of the device in which the repository is embedded. For example, the repository could be embedded in a "card" that is inserted into an available slot in a computer system. The user interface may be combination of a display, keyboard, cursor control device and software executing on the computer system.").

However, **Krishnan** et al. clearly disclose "a field containing license acquisition information including a location of a license provider", see **Krishnan** et al., "in Table 1 the CommerceServer field indicates the location of the licensing and purchasing broker (e.g., the network address of licensing and purchasing broker 307 in FIG. 3) to be used to license and purchase the merchandise." .

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the system of **Stefik**, with **Krishnan**'s idea in a software program, because artisan in this specific field would appreciate extra information of "a location of a license provider" for extra and complete information relating to a digital content; furthermore, because components in this structure must be distinguished from cited prior art in terms of structure rather than function(s).

B. Re. To claim 122: The examiner submits that it is obvious to one with skill in the art that "license acquisition information" are not necessary for encryption since this particular unencrypted information can be revealed to different sources (e.g., accounting department etc.).

C. Re. To claims 123/124: The examiner submits that it is obvious to one with skill in the art that "license provider location is a network/Internet address" since network/Internet addresses have been very popular for accessing in communications for obtaining info. or distributions at the time of filing this pending application.

D. Re. To claim 125: **Stefik** suggests that a content provider having a public key and a private key, and a data structure including a field containing the content provider public key (see **Stefik**, "At this point, assuming that the transaction has not terminated, the repositories exchange messages containing session keys to be used in all communications during the session and synchronize their clocks. FIG. 17 illustrates the session information exchange and clock synchronization steps (again from the perspective of repository-1.) Referring to FIG. 17, repository-1 creates a session key pair, step 1701. A first key is kept private and is used by repository-1 to encrypt messages. The second key is a public key used by repository-2 to decrypt messages. The second key is encrypted using the public key of repository-2, step 1702 and is sent to repository-2, step 1703. Upon receipt, repository-2 decrypts the second key, step 1704. The second key is used to decrypt messages in subsequent communications. When each repository has completed this step, they are both convinced that the other repository is bona fide and that they are communicating with the original. Each repository has given the other a key to be used in decrypting further communications during the session. Since that key is itself

transmitted in the public key of the receiving repository only it will be able to decrypt the key which is used to decrypt subsequent messages.”).

E. Re. To claim 126: **Stefik** suggests that a content provider public key is encrypted according to a decryption key (see **Stefik**, “Because the communication line is assumed to be unsecured, all communications with repositories that are above the lowest security class are encrypted utilizing a public key encryption technique. Public key encryption is a well known technique in the encryption arts. The term key refers to a numeric code that is used with encryption and decryption algorithms. Keys come in pairs, where “writing keys” are used to encrypt data and “checking keys” are used to decrypt data. Both writing and checking keys may be public or private. Public keys are those that are distributed to others. Private keys are maintained in confidence.”).

F. Re. To claim 127: **Stefik** suggests that encrypted content provider public key is signed by the content provider private key, and wherein alteration of the encrypted content provider public key prevents validation of the data structure (see **Stefik**, “Because the communication line is assumed to be unsecured, all communications with repositories that are above the lowest security class are encrypted utilizing a public key encryption technique. Public key encryption is a well known technique in the encryption arts. The term key refers to a numeric code that is used with encryption and decryption algorithms. Keys come in pairs, where “writing keys” are used to encrypt data and “checking keys” are used to decrypt data. Both writing and checking keys may be public or private. Public keys are those that are distributed to others. Private keys are maintained in confidence.”).

G. Re. To claim 128: The data structure of claim 125 wherein the content provider public key is signed by the content provider private key, wherein alteration of the content provider public key prevents validation of the data

structure (see **Stefik**, "Because the communication line is assumed to be unsecured, all communications with repositories that are above the lowest security class are encrypted utilizing a public key encryption technique. Public key encryption is a well known technique in the encryption arts. The term key refers to a numeric code that is used with encryption and decryption algorithms. Keys come in pairs, where "writing keys" are used to encrypt data and "checking keys" are used to decrypt data. Both writing and checking keys may be public or private. Public keys are those that are distributed to others. Private keys are maintained in confidence.").

H. Re. To claim 129: **Stefik** suggests that structure comprising a key ID identifying a decryption key (see **Stefik**, "Each repository has given the other a key to be used in decrypting further communications during the session. Since that key is itself transmitted in the public key of the receiving repository only it will be able to decrypt the key which is used to decrypt subsequent messages.").

6. Claims 130-135 are rejected under 35 U.S.C.S 103(a) as being unpatentable over **Stefik** (US Pat. 5,715,403), in view of the Official Notice.

The examiner takes Official Notices that below features in a computer-readable medium are old and well-known:

A. Re. To claim 130: a data structure containing a certificate.

B. Re. To claim 131: a certificate includes a public key of a content provider.

C. Re. To claim 132: a certificate is signed with a private key.

D. Re. To claim 133: a data structure containing a first certificate, and a second certificate.

E. Re. To claim 134: a first certificate includes the public key, and a second certificate includes another public key.

F. Re. To claim 135: a first certificate is signed with a private key, a second certificate is signed with another private key.

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the system of **Stefik**, with **Krishnan's** idea in a computer-readable medium, because artisan in this specific field would appreciate available information of a license/certificate for a software package, public/private key pair and their usage; furthermore, because components in this structure must be distinguished from cited prior art in terms of structure rather than function(s).

G. Re. To claim 106: This claim contains similar features as in claim 121. Therefore, similar rationales and references set forth are applied for rejection under 35 U.S.C. § 103(a).

H. Re. To claim 107: This claim contains similar features as in claim 122. Therefore, similar rationales and references set forth are applied for rejection under 35 U.S.C. § 103(a).

I. Re. To claim 108: This claim contains similar features as in claim 123. Therefore, similar rationales and references set forth are applied for rejection under 35 U.S.C. § 103(a).

J. Re. To claim 109: This claim contains similar features as in claim 124. Therefore, similar rationales and references set forth are applied for rejection under 35 U.S.C. § 103(a).

K. Re. To claim 110: This claim contains similar features as in claim 125. Therefore, similar rationales and references set forth are applied for rejection under 35 U.S.C. § 103(a).

L. Re. To claim 111: This claim contains similar features as in claim 126. Therefore, similar rationales and references set forth are applied for rejection under 35 U.S.C. § 103(a).

N. Re. To claim 112: This claim contains similar features as in claim 127. Therefore, similar rationales and references set forth are applied for rejection under 35 U.S.C. § 103(a).

O. Re. To claim 113: This claim contains similar features as in claim 128. Therefore, similar rationales and references set forth are applied for rejection under 35 U.S.C. § 103(a).

P. Re. To claim 114: This claim contains similar features as in claim 129. Therefore, similar rationales and references set forth are applied for rejection under 35 U.S.C. § 103(a).

Q. Re. To claim 115: This claim contains similar features as in claim 130. Therefore, similar rationales and references set forth are applied for rejection under 35 U.S.C. § 103(a).

R. Re. To claim 116: This claim contains similar features as in claim 131. Therefore, similar rationales and references set forth are applied for rejection under 35 U.S.C. § 103(a).

S. Re. To claim 117: This claim contains similar features as in claim 132. Therefore, similar rationales and references set forth are applied for rejection under 35 U.S.C. § 103(a).

T. Re. To claim 118: This claim contains similar features as in claim 133. Therefore, similar rationales and references set forth are applied for rejection under 35 U.S.C. § 103(a).

U. Re. To claim 119: This claim contains similar features as in claim 134. Therefore, similar rationales and references set forth are applied for rejection under 35 U.S.C. § 103(a).

V. Re. To claim 120: This claim contains similar features as in claim 135. Therefore, similar rationales and references set forth are applied for rejection under 35 U.S.C. § 103(a).

7. The examiner submits that all claimed limitations are features/capabilities of cited computer systems, they are recognized to be included as software components of a digital rights management system; cited prior art limitations are not necessary spelled-out exactly claimed languages, because cited prior art is also directed to a similar system for managing digital rights. **Krishnan, Stefik**, or submitted IDS references are not limited to the described embodiments in their inventions. It is reasonable that various modifications of described methods and systems of the cited prior art would be apparent to those skilled in the art without departing from the scope and spirit of the invention. Although their inventions have been described in

connection with specific preferred embodiments, it should be understood that their inventions as claimed should not be unduly limited to such specific embodiments.

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the system of **Stefik**, and **Krishnan**, in view of the Official Notice with suggestions readily available in the art submitted in the IDS, because artisan in this specific field would appreciate these disclosed information for improvement of communication and security in a digital right management system.

Conclusion

8. Claims 106-135 are not patentable.

9. These references are considered pertinent to applicants' disclosure.

- Krishnan, (US Pat. 6073124 - 6/06/2000), Method and system for securely incorporating electronic information into an online purchasing application

- Stefik, (US Pat. 5,715,403), discloses about a system for controlling the distribution and use of digital works having attached usage rights where the usage rights are defined by a usage rights grammar.

- Stefik et al., (US Pat. 5,629,980), discloses about a system for controlling the distribution and use of digital works.

- Van Wie et al., (US Pat. 5,943,422), discloses about a steganographic techniques for securely delivering electronic

digital rights management control information over insecure communication channels.

- Ginter et al., (US Pat. 5,982,891), discloses about a system and a method for secure transaction management and electronic rights protection.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cuong H. Nguyen whose telephone number is 703-305-4553. The examiner can normally be reached on Mon.-Fri. from 7:00 AM to 3:15 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins, can be reached on (703) 308-1344.

Any response to this action should be mailed to:

Amendments

*Commissioner of Patents and Trademarks
Washington D.C. 20231*

or faxed to:

(703) 305-7687 [Official communications; including After Final communications labeled "Box AF"]

703-746-5572 (RightFax) Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Cuonghnguyen
Primary Examiner
Feb. 09, 2003